



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,585	01/19/2000	Scott Wayne Weller	104433	3330

7590 01/24/2006
Oliff & Berridge PLC
P O Box 19928
Alexandria, VA 22320

EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,585

Applicant(s)

WELLER, SCOTT WAYNE

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 8-10, 12-15, 18, 19, 21 and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8-10, 12-15, 18, 19, 21 and 24-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 11/7/05.
2. Claims 1, 5, 8 – 10, 12 – 15, 18, 19, 21 and 24 – 40 are pending in the case. Claims 1, 15 and 21 are independent.
3. The rejection of claims under 35 U.S.C. 102(e) as being anticipated has been withdrawn as necessitated by amendment.
4. The rejection of claims under 35 U.S.C. 103(a) as being unpatentable has been maintained.
5. The rejection of claims under 35 U.S.C. 112, second paragraph as being indefinite has been withdrawn as necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 5, 8 – 10, 13 – 15, 18, 19, 21, 24 and 38 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolff (US 6738841 B1).
2. **Regarding independent claims 1, 15, and 21**, Wolff teach that *The browser client is operable to receive server documents from the server via the network* (Abstract, lines 3 & 4), compare with **receiving a document**. Wolff teach that *Referring to FIG. 5a*,

Art Unit: 2176

a web page including "CHI 97 Electronic Publications: LateBreaking/Short Talks" is displayed on browser 320. The CHI 97 page includes various links to other web pages. FIG. 5b shows the CHI 97 page after the browser 320 display has been scrolled down (Column 7, lines 45 - 49), compare with **determining whether the received document contains a link to a retrievable item**; that FIG. 6 illustrates one embodiment of a book selection page 600 displayed on browser 320 after the selection of the "CHOOSE CONTENTS FOR BOOK" button. Upon selection of the "CHOOSE CONTENTS FOR BOOK" button, print server 250 fetches the web document with the URL specified in bookmaker page 400 (e.g., the CHI 97 page) and renders the document based upon a predetermined format. Selection page includes controls that allow a user to select links that are to be included in the created book. For example, book selection page 600 shows the "Emotional Usability of Customer Interfaces . . . ", "World Wide Web as Usability Tester . . . ", "Notes on Pattern Language . . . ", and "Effective Product Selection in Electronic Catalogs" links of the CHI 97 web page shown in FIG. 5a and 5b as being selected to be included in a book (Column 7, lines 50 - 64), compare with **inserting injectable control content into the received document at a specified location adjacent to the link to the retrievable item**; that After selection at book selection page 600, the selection data is transmitted to printer driver 255. Printer driver 255 waits for further instructions from client 210 on how to use the selected links. FIG. 7 illustrates one embodiment of a book view page 700 displayed on browser 320. View page 700 is displayed after the selecting the "PREVIEW" button on create book page 400. View page 700 displays pages of links selected by a user to be printed in a book

(Column 7, line 64 – Column 8, line 5), compare with **outputting the received document including the injectable control content to a display device, wherein the injectable control content may be selected by a user to perform a functional operation upon the retrievable item identified by the link**. In addition, Wolff teach that *it is appreciated that throughout the present invention, discussions utilizing terms such as "processing" or "computing" or "calculating" or "determining" or "displaying" or the like, refer to the action and processes of a computer system, or similar electronic computing device, that manipulates and transforms data represented as physical (electronic) quantities within the computer system's registers and memories into other data similarly represented as physical quantities within the computer system memories or registers or other such information storage, transmission or display devices* (Column 4, lines 12 – 22), compare with **a content database that stores injectable control content and a memory that stores a location ...**, since NetLingo defines database as *An organized collection of information, characterized by the use of data fields, it provides a foundation for procedures such as retrieving information, drawing conclusions, and making decisions. In other words, it is an electronic filing system* (<http://www.netlingo.com/lookup.cfm?term=database>).

3. **Regarding dependent claims 5, 8, 18, 24 and 38**, Wolff teach that *After selection at book selection page 600, the selection data is transmitted to printer driver 255. Printer driver 255 waits for further instructions from client 210 on how to use the selected links. FIG. 7 illustrates one embodiment of a book view page 700 displayed on browser 320. View page 700 is displayed after the selecting the "PREVIEW" button on*

*create book page 400. View page 700 displays pages of links selected by a user to be printed in a book (Column 7, line 64 – Column 8, line 5) and further illustrated in Figs 6 & 7, compare with **the retrievable item identified in the received document is at least one of a file, a folder, a picture, a movie, a sound, or a document; the injectable control content includes at least one of an document printing function, an document storing function, a processing function, or a document viewing/editing function; and the functional operation is performed by the display device.***

4. **Regarding dependent claim 9 and 19**, Wolff teach that *As shown in FIGS. 3a and 3b, printer server 255 formats print view page 350 with controls not found on the original document, including the button controls 360 discussed above and a control indicating the URL of the page being viewed. The rendering function of printer server 255 provides an accurate print view. Accordingly, it is not necessary for manufacturers of browsers included with client 210 to code printer drivers for many different printers since functionality can change without change to the browser or host software (Column 6, lines 32 – 42), compare with **the injectable control content provides processing of the retrievable item without installing software on an accessing device.***

5. **Regarding dependent claims 10 and 39**, Wolff teach that *FIG. 6 illustrates one embodiment of a book selection page 600 displayed on browser 320 after the selection of the "CHOOSE CONTENTS FOR BOOK" button. Upon selection of the "CHOOSE CONTENTS FOR BOOK" button, print server 250 fetches the web document with the URL specified in bookmaker page 400 (e.g., the CHI 97 page) and renders the*

document based upon a predetermined format. Selection page includes controls that allow a user to select links that are to be included in the created book. For example, book selection page 600 shows the "Emotional Usability of Customer Interfaces . . . ", "World Wide Web as Usability Tester . . . ", "Notes on Pattern Language . . . ", and "Effective Product Selection in Electronic Catalogs" links of the CHI 97 web page shown in FIG. 5a and 5b as being selected to be included in a book (Column 7, lines 50 - 64), compare with **the functional operation is performed by a server that is separate from, and in communication with, the display device (Figure 2); receiving the document comprises receiving the document at a server; and inserting the injectable control content includes the server associating the injectable control content with a retrievable item.**

6. **Regarding dependent claims 13 and 14,** *Wolff teach that A network printer is described that is coupled to a network and is able to respond to requests from the network. In one embodiment, the requests are associated with the World Wide Web (the WWW). The printers act as World Wide Web (WWW) servers. That is, printers are directly coupled to a local area network (LAN) or wide area network (WAN) and "serve" data, such as images or other multi-media objects, that they capture or create to requesting agents on the network (Column 4, lines 56 – 64), compare with* **wherein receiving document includes receiving document using at least one of either a wired connection or a wireless to a network and wherein outputting the document includes forwarding using at least one of either a wired connection or a wireless to the display device.**

7. **Regarding dependent claim 40**, Wolff teach that *The browser client is operable to receive server documents from the server via the network* (Abstract, lines 3 & 4), compare with **the document is received at the display device; and** Wolff teach that *FIG. 3a illustrates one embodiment of a document 300 printed at printer 250. Printer driver 255 also attaches control buttons to the retrieved document and transmits the print view version of the document to the user at client 210. FIG. 3b illustrates one embodiment of a print view page 350 of a document displayed on a browser 320 residing in client 210. View page 350 includes control buttons 360 labeled "PRINT", "OPTIONS", and "STATUS". The "PRINT" button contains a tag that causes printer server 255 to transmit the document for download to the digital hardware and print engine components of printer 250. The "OPTIONS" and "STATUS" buttons cause printer server 255 to serve up an option selection form and a printer status page, respectively* (Column 6, 7 - 19), compare with **the injectable control content is inserted by the display device.**

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6738841 B1) as applied to claim 1 above, and further in view of Yang et al. (US006301586B1).

10. **Regarding dependent claim 12**, Wolff do not explicitly teach **the specified location** ... However, Yang et al. discloses in Figure 14 that **the specified location to insert the injectable content is determined by a user** (*selecting the print layout*). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Wolff with that of Yang et al. because such a combination would provide the users of Wolff with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Yang et al., Column 1, lines 44 – 47).

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6738841 B1) as applied to claim 21 above.

12. **Regarding dependent claim 25**, Wolff teach that *FIG. 3a illustrates one embodiment of a document 300 printed at printer 250. Printer driver 255 also attaches control buttons to the retrieved document and transmits the print view version of the document to the user at client 210. FIG. 3b illustrates one embodiment of a print view page 350 of a document displayed on a browser 320 residing in client 210. View page 350 includes control buttons 360 labeled "PRINT", "OPTIONS", and "STATUS". The "PRINT" button contains a tag that causes printer server 255 to transmit the document for download to the digital hardware and print engine components of printer 250. The*

"OPTIONS" and "STATUS" buttons cause printer server 255 to serve up an option selection form and a printer status page, respectively (Column 6, lines 7 – 20), compare with **at least one injectable control content includes at least one selectable icon to access at least one treatment option screen.**

13. Claims 26 – 29, and 31 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6738841 B1) as applied to claim 25 above, and further in view of Yang et al. (US006301586B1).

14. **Regarding dependent claim 26 – 29, and 35 – 37**, Wolff does not explicitly teach **a treatment option screen**. However, Yang et al. discloses in Figure 13 that **the treatment option screen has an option to process retrievable item, the treatment option screen is separately displayed for each retrievable item, each treatment option screen is sequentially displayed for each retrievable item, the treatment option screen includes a selectable icon to return to a previous treatment option window (Back), the treatment option screen includes a selectable icon to accept the treatment (Finish), the treatment option screen includes a selectable icon to exit (Cancel), and the treatment option screen comprises at least one portion ...** . It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Wolff with that of Yang et al. because such a combination would provide the users of Wolff with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Column 1, lines 44 – 47).

15. **Regarding dependent claims 31 – 34**, Wolff does not explicitly teach a **treatment option screen**. However, Yang et al. discloses in Figures 13 – 16 that **the treatment option screen lists each retrievable item (Left Box), the list includes at least one markable box (Right Box), and each marked box indicates that the associated retrievable item is to be processed**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Wolff with that of Yang et al. because such a combination would provide the users of Wolff with *an improved management of multimedia objects by means of enhanced input, manipulation, and output* (Yang et al., Column 1, lines 44 – 47). Further, it would have been obvious to one with ordinary skill in the art at the time of the invention to know that since the combined invention already performs the demarcation of boxes in one manner then it would be trivial to make so that each marked box indicates that the associated downloadable information is not to be processed.

16. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6738841 B1) as applied to claim 25 above, and further in view of Roosen et al. (US006618163B1).

17. **Regarding dependent claim 30**, Wolff does not explicitly teach **the treatment option screen ...** However, Roosen et al. discloses in Figure 8 that **the treatment option screen has at least one first portion, at least one second portion, and at least one control for moving...** It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Wolff with that of Roosen

et al. because such a combination would provide the users of Wolff the benefit of having *access to an invention that meets the need for enhanced printer status information, monitoring and control* (Column 2, lines 10 – 11).

Response to Arguments

18. Applicant's arguments with respect to claims 1, 5, 8 – 10, 12 – 15, 18, 19, 21 and 24 – 40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100